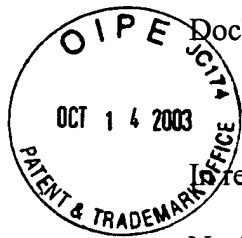


-1max



Docket No.: 49657-862

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Is re Application of

Naoki TSUJI

Serial No.: 09/745,468

Filed: December 26, 2000

For: SEMICONDUCTOR DEVICE AND A PRODUCTION METHOD FOR THE SAME

: Customer Number: 20277

:

: Confirmation Number: 1840

:

: Group Art Unit: 2814

:

: Examiner: S. Rao

:

LETTER

Mail Stop Letter  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant is in receipt of the Final Office Action dated September 18, 2003 wherein the Examiner imposed a rejection under 35 U.S.C. § 103 for obviousness predicated upon Shimizu et al. in view of Kawashima et al. However, U.S. Patent 6,153,918 (Kawashima et al.) was **not** the actual reference relied upon. Rather, the Examiner relied upon a Japanese Patent Publication No. 2000-227211, asserted to be a priority document of Kawashima et al. The Examiner **admits** that the Japanese Patent Publication is "newly applied". However, the Examiner **failed** to provide Applicants with a copy of this reference which was actually relied upon, **failed** to list that reference on a PTO-892 and, significantly, **failed** to provide a complete English language translation of the actually relied upon document. Applicant has, therefore, been denied due process of law because it cannot be determined whether the relied upon Japanese Patent Publication actually contains what the Examiner says it contains.

Moreover, in the Request for Consideration submitted June 11, 2003, Applicant argued that the Examiner did not establish the requisite facts or motivation to support the obviousness conclusion. Applicant specifically argued that the Examiner failed to identify wherein Kawashima et al. disclose or suggest a device wherein dummy trench isolation patterns comprise a trench pattern which constitutes a positioning mark extending in the second direction different from the first direction and connecting the dummy trench isolation pattern. Applicant noted that layer 20a in Fig. 5 of Kawashima et al. is an impurity region; however, element 55 in Fig. 8 of Shimuzu et al. is an oxide layer. It was argued that the Examiner did not identify wherein either of these elements constitutes a positioning mark or is capable of functioning as a positioning mark.

The Examiner failed to respond to these arguments again relying on layer 20a in Fig. 5 of Kawashima et al. The Examiner's failure to respond to Applicant's arguments is inconsistent with the mandate of the MPEP § 707.07(f). This failure, coupled with the Examiner's citation of a newly applied reference without providing that reference or an English translation of and making the rejection final constitutes arbitrary agency action.

In view of the above, Applicant hereby requests:

1. The Examiner issue a proper new Office Action complete with a new PTO-892 listing the actual reference relied upon;
2. Provide Applicant with the actual reference relied upon and a complete English language translation thereof;
3. Withdraw the finality of the September 11, 2003 Office Action since it was not provoked by an Amendment but by the Examiner's reliance upon a "newly applied" reference; and
4. Restart the period for response.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 AJS:mcm  
Facsimile: (202) 756-8087  
**Date: October 14, 2003**